

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-15 are pending and claims 16-168 are withdrawn. In this Amendment, 3 and 4 are amended. No new matter is added.

Support for the amendment to paragraph 171 of the specification is found in the originally filed specification at in paragraphs 170 and 171, as well as elsewhere in the originally filed specification, drawings, and claims.

The Examiner is thanked for indicating that claim 15 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicant thanks the Examiner for the courtesies extended to Applicants' representative during a December 16, 2004, Telephone Interview (Examiner Interview) in which the outstanding rejections were discussed. Applicant's separate record of the substance of the interview is contained in the comments below.

Claims 1-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,229,972 to Rushing (Rushing). This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 1 claims a device comprising a recursive feedback control means for controlling at least one pulse width using recursive feedback wherein the pulse width is used to drive an electrode means. However, as discussed during the Examiner Interview, nowhere does Rushing teach or suggest any means for controlling a pulse width, much less controlling a pulse width using recursive feedback. Also, as discussed during the Examiner Interview, Rushing also does not teach or suggest using a pulse width to drive an electrode means. In addition, as discussed during the Examiner Interview, Rushing does not even use the term "pulse width" and nowhere in Rushing is there any term that corresponds to "pulse width." For the above reasons, Rushing cannot teach or suggest the

device of claim 1, claim 1 is patentable over Rushing, and the rejection of 1 under 35 U.S.C. § 102(b) based on Rushing should be withdrawn.

Claims 2-5 depend directly or indirectly from claim 1, and, accordingly, include all of the patentable features of claim 1 as well as other patentable features. Therefore, claims 2-5 are patentable over Rushing for at least the reasons discussed above with respect to claim 1 and the rejection of claims 2-5 under 35 U.S.C. § 102(b) based on Rushing should be withdrawn.

In addition, with respect to claim 5, as discussed during the Examiner Interview, there is no part of Rushing cited in the Office Action as a basis for the rejection of claim 5 under 35 U.S.C. § 102(b) based on Rushing, and, therefore, the rejection of claim 5 under 35 U.S.C. § 102(b) based on Rushing should be withdrawn for this reason as well.

Claims 6-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,229,972 to Rushing (Rushing) in view of U.S. Patent No. 4,847,854 to Van Dijk (Van Dijk). This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 1 is patentable over Rushing for the reasons discussed above, including the failure of Rushing to teach or suggest anything about pulse widths. Van Dijk also does not use the term “pulse width”, does not teach or suggest any means for controlling a pulse width as claimed by claim 1, and does not teach or suggest using a pulse width to drive an electrode means as claimed by claim 1. Therefore, Van Dijk cannot remedy the deficiencies of Rushing, and claim 1 is patentable over the combination of Van Dijk with Rushing.

Claims 6-14 depend from claim 1, and, accordingly, include all of the patentable features of claim 1 as well as other patentable features. Therefore, claims 6-14 are patentable over the combination of Van Dijk with Rushing for at least the reasons discussed above with respect to claim 1 and the rejection of claims 6-14 under 35 U.S.C. § 103(b) based on the combination of Van Dijk with Rushing should be withdrawn.

In addition, the combination of Van Dijk with Rushing is *prima facie* improper because the Office Action has cited no portion of Rushing that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Van Dijk with the teachings of Rushing. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness.” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”)).

Without citing any motivation in Rushing for combining the teachings of Van Dijk with the teachings of Rushing, the Office Action merely makes the following conclusory statement: “Thus it would have been obvious to one in the ordinary skill the art at the time of the invention was made to incorporate the teaching of Van Dijk [into] the teaching of Rushing to be able to reduce the [electronic] noise and since recursive feedback control based upon all data entered it minimizes storage requirement” (See Office Action, p. 4). However, the Office Action fails to cite any portion of Rushing that relates to “electronic noise” or “minimizing storage requirements.” In fact, the Office Action fails to cite any portion of Rushing, or any other prior art reference that would provide motivation for a person of ordinary skill in the art reading Rushing to look for Van Dijk. Because the Office Action has cited no portion of Rushing that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Van Dijk with the teachings of

Rushing, the combination of Van Dijk with Rushing is *prima facie* improper and the rejection of claims 6-14 under 35 U.S.C. § 103(a) based on the combination of Van Dijk with Rushing should be withdrawn.

For the above reasons, claims 6-14 are patentable over the improper combination of Van Dijk with Rushing.

In addition, with respect to claims 1-5, these claims have been rejected on the basis of facts within the personal knowledge of the Examiner. In rejecting claims 1-5, the Examiner makes the assertion that Rushing teaches a recursive feedback control means for controlling at least one pulse width using recursive feedback and teaching using a pulse width to drive an electrode means (See Office Action, p. 2). However, the Examiner has failed to cite any portion of Rushing that teaches doing anything with a pulse width. In fact, Rushing never uses the term “pulse width” or any equivalent term to “pulse width.” Accordingly, under 37 C.F.R. § 1.104(d)(2) the Applicants hereby request that the Examiner provide an affidavit or declaration supporting the Examiner’s assertion used as a basis for this rejection.

In addition, with respect to claims 6-14, these claims have been rejected on the basis of facts within the personal knowledge of the Examiner. The Examiner asserts the following basis for combining Van Dijk with Rushing in rejecting claims 6-14 under 35 U.S.C. § 103(a): “Thus it would have been obvious to one in the ordinary skill in the art at the time of the invention was made to incorporate the teaching of Van Dijk [into] the teaching of Rushing to be able to reduce the [electronic] noise and since recursive feedback control based upon all data entered it minimizes storage requirement” (See Office Action, p. 4). However, the Office Action fails to cite any portion of Rushing that relates to “electronic noise” or “minimizing storage requirements.” In fact, the Office Action fails to cite any portion of Rushing, or any other prior art reference in support of the Examiner’s conclusory statement used as a basis for combining the teachings of Van Dijk with the teachings of Rushing in rejecting claims 6-14. Accordingly, under 37 C.F.R. § 1.104(d)(2) the Applicants hereby request that the Examiner provide an affidavit or declaration supporting the Examiner’s assertion used as a basis for this rejection.

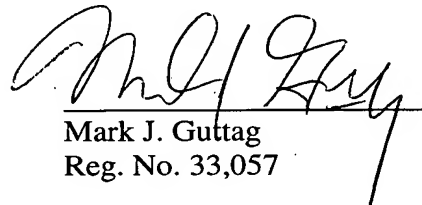
At page 6 of the Office Action, Claim 15 is objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and intervening claim

This objection is respectfully traversed with respect to Claim 15 as currently presented. Claim 15 ultimately depends from Claim 1. For reasons previously given, Claim 1 is patentable over the art relied on in this Office Action. Accordingly, Claim 15 ultimately depends from an allowable base claim, and therefore does not need to be rewritten in independent form

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



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